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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,023	01/10/2002	Toshihiro Morita	450101-02844	4611

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EXAMINER

CHEN, TE Y

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 11/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/889,023	Applicant(s) MORITA ET AL.	
	Examiner Susan Y. Chen	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-43 and 48-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-43 and 48-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/29/05</u> . | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

Claim Status

This office action is in response to the amendment filed on 09/15/2005. Claim 41-43, 48-66 are pending for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 41-43 and 48-66, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,412,012 issued to Bieganski et al. (hereinafter referred as '012 Bieganski) in view of U.S. Patent No. 6,959,288 issued to Medina et al. (hereinafter referred as '288 Medina).

Claims 41, 48, 53, 55, 60, and 62:

Bieganski discloses an information processing system as claimed [e.g., Fig. 1] comprising:

- means for recording usage history data and the related data recorded in the recording means based on the filtering data [e.g.,

the CPU (102, Fig. 1) can coupled to the memory system (104, Fig. 1) and the secondary storage(108 of Fig. 1) to log history data indicative of usage history of the group of contents. For example, the data being stored in the History Set (203), Fig. 2; or the customer's behavior data recorded at a shopping set being specified at col. 8, lines 7-8; or the Purchased Items associated to a particular user's Transaction or the total number of Transaction being purchased of the unit 900, Fig(s). 9; the Recommendation engine (600, Fig. 14; col. 14, lines 31-33)];

- means for computing per each of the contents a weight related to a number of checkout from the history data and the related data recorded in the recording means based on the filtering data [e.g., the compatibility modifier (200, Fig. 2) can accept a stored number of checkout (or the number of times each item was purchased, Fig. 9) per each of the contents from the history data on a filtering rule specified by a marketer or customer or the processing of recommendation engine itself (col. 9, lines 63-49) to compute a weight related to the number of checkout (the steps 752-756, Fig. 7A)];
- means for selecting a content from a group of contents based on weight computed by the computing means [e.g., the user interface adapter coupled to the Input Device (114, 118, Fig 1) can be used

to select the modified recommendation set based on weight computed by the compatibility modifier (Fig. 5; Fig. 6; col. 13, line 21 - col. 14, line 14; col. 14, line 31-col. 15, line 2));

- means for display a list of at least titles in the information related to the contents selected by the selecting means [e.g., the Display Adapter (112, Fig. 1) coupled to the Display Device (116, Fig. 1) can display a list of recommended books selected by the book reviewer (col. 7, lines 49-54)].

'012 Bieganski did not specifically disclose that a checkout occurs when contents are copied from the information processor to a separate device in accordance with usage rule data which includes rules on the number of checkouts for each of the contents.

However, '288 Medina discloses an information processing system comprising a checkout occurs when contents are copied from the information processor to a separate device in accordance with usage rule data which includes rules on the number of checkouts for each of the contents [e.g., '288 Medina: the end user of the devices (109, Fig. 1D) activates the player application (195, Fig. 1D) to copy (or checkout) songs to CD (col. 93, line 65) according to the usage rules tracked by the clearing house (105, Fig. 1C) or the content providers (101, Fig. 1A), wherein the rules comprise the number of checkout for each of the contents (col. 90, lines 5-60); The player Application 195 section, col. 87, line 25 – col. 91, line 10; Fig.(s) 15 -16 and associated texts].

'012 Bieganski and '288 Medina are both in a network information processing system comprising user interface to perform checkout operations, therefore, with the teachings of Bieganski and Medina in front of him/her, it would have been obvious for one of the ordinary skill person in the art at the time the invention was made to modify Bieganski's system with the technique taught by Medina to provide a checkout operation that occurs when contents are copied from the information processor to a separate device in accordance with usage rule data which includes rules on the number of checkouts for each of the contents, because by doing so, as suggested by Medina the combined system will provides a standard for creating digital players on end-user device that allows an end user to manage of a local library of digital contents no other than what was purchased [e.g., col. 5, lines 39-53].

As to claims 42, 49, 51-52, 54, 56, 58-59, 61, 63, and 65-66:

Except all the features recited in claims 41, 48, 53, 55, 60, and 62, the combined system of Bieganski and Medina further discloses that the system comprising means to computes per each of the contents as weight for a period for which the content has been checked out or for the genre of the content or for playing time of the content [e.g., '288 Medina: col. 13, lines 1-9; col. 93, line15].

As to claims 43, 50, 57 and 64:

Art Unit: 2161

Except all the features recited in claims 41, 48, 53, 55, 60, and 62, the combined system of Bieganski and Medina further discloses that the system comprising means for adding new filtering data [e.g., '288 Medina: col. 11, lines 19-22].

Response to Arguments

Applicant's arguments with respect to claims 41-43 and 48-66 filed on 03/23/2005 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

To expedite the process of re-examination, the examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. 35 U.S.C. 112) set forth by the Examiner prior to the office action, that applicant should provide and link to the most specific page and line numbers of the disclosure where best support is found (see 35 U.S.C. 132).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Wachi et al. (U.S. Patent No. 5,880,386) which discloses a musical information processing system with automatic data transfer.

Art Unit: 2161

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y. Chen whose telephone number is 571-272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susan Y Chen
Examiner
Art Unit 2161

November 21, 2005


UYEN LE
PRIMARY EXAMINER